UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte: SUNDARAM RAMAKESAVAN
and PHILLIP J. SILVIA

Appeal No. 2006-0944
Application No. 09/895,584

ON BRIEF

Before Hairston , Krass and Blankenship, **Administrative Patent Judges**.

Krass, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-9, 11-21, and 24-30.

The invention is directed to a method, article and system for selecting wireless devices.

The method is set forth in representative independent claim 1, reproduced as follows:

1. A method comprising:

remotely selecting one of a plurality of devices for wireless communications using a device having operators associated with at least two of said devices, and enabling different actuations of said operators to be interpreted selectively as either the selection of a device for communication or the programming of the operator to communicate upon actuation with a particular device.

The examiner relies on the following references:

Goldstein	5,410,326	Apr. 25, 1995
Darbee et al. (Darbee)	2001/0010503	Aug. 02, 2001 (filed Feb. 23, 2001)
Kolde et al. (Kolde)	2002/0175944	Nov. 28, 2002 (filed May 23, 2001)
Erekson	6,622,018	Sep. 16, 2003 (filed Apr. 24, 2000)

Claims 1-9, 11-21, and 24-30 stand rejected under 35 U.S.C. §103. As evidence of obviousness, the examiner offers Erekson and Goldstein with regard to claims 1-7, 9, 11-17, 19, and 20, adding Darbee with regard to claims 8 and 18. With regard to claims 21, 24-27, 29, and 30, the examiner offers Erekson and Kolde, adding Darbee with regard to claim 28.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

With regard to independent claims 1 and 11, the examiner contends that Erekson discloses a portable computer system, at column 5, lines 33-41, that reads on the claimed "medium," and a storing of communicated information, at column 5, lines 40-43, for enabling the portable computer system, which is said to read on the claimed "processor based systems."

The examiner points to column 2, lines 27-30, of Erekson for remotely selecting one of a plurality of devices 10, 20, 30, 40 with which to communicate. The examiner notes, however, that Erekson fails to teach a plurality of devices for wireless communication using a device having operators associated with at least two of the devices, enabling different actuations of the operators associated with the at least two of the devices, and enabling different actuations of operators to be interpreted selectively as either the selection of a device for communication or programming of the operator to communicate upon actuation with a particular device.

The examiner turns to Goldstein for a teaching, at column 3, lines 14-28, and 58-67, and column 4, lines 6-10, of a universal programmable remote control device with the capability of selecting a plurality of wireless devices and enabling different actuations of icons representing various services for each controlled device. The examiner contends that this teaching of Goldstein reads on "said operators associated with at least two of the said devices."

The examiner further asserts that Goldstein discloses enabling different actuations of the icons to be interpreted selectively as either the selection of a device for communication or programming of the icons to communicate upon actuation with a particular device.

The examiner concludes that it would have been obvious to modify Erekson "to include Goldstein...in order to for the said remote device to be functionally capable to select a plurality of devices to communicate within an environment to further program the said icon to communicate the said selected device" [sic] (Final rejection-Paper No. 4, August 26, 2004 - page 3).

Appellants argue that, as admitted by the examiner, Erekson does not disclose a device having the operators of claims 1 and 11, but they also argue that Goldstein does not cure this deficiency of Erekson. The reason asserted by appellants is that Goldstein is directed to a universal remote that does not interpret different actuations of the operators selectively, as required by the claims. While Goldstein does disclose a touch screen display for producing icon menus that a user may use to select a particular device and/or programming service, appellants argue that the mere selection of a device or programming service using a universal remote control is not the same as enabling different actuations of operators to be interpreted selectively. That is, "there is no teaching in the cited passages of Goldstein that icons can be actuated in different ways to produce a different result depending on the type of actuation" (principal brief-page 13).

We have considered the evidence in this case, including the disclosures of the applied references and the arguments of appellants and the examiner and we conclude therefrom that the examiner has not established a prima facie case of obviousness within the meaning of 35 U.S.C. §103.

As both parties admit, Erekson lacks any teaching of the "operators," as claimed, "enabling different actuations of said operators to be interpreted selectively as either the selection of a device for communication or the programming of the operator to communicate upon actuation with a particular device." Thus, in order for the examiner's rejection to be upheld, this deficiency of Erekson must be taught or suggested by Goldstein and, even if taught or suggested

by Goldstein, there must have been something in the prior art which would have suggested the combination of Erekson and Goldstein.

We have reviewed the Goldstein reference and find nothing therein "enabling different actuations of said operators to be interpreted selectively as either the selection of a device for communication or the programming of the operator to communicate upon actuation with a particular device." Rather, a user of Goldstein's device touches various icons on a touch screen and a linked menu screen appears (note Column 9, lines 4-14), but we find nothing therein indicative of actuating these icons in one way to be interpreted selectively as a selection of a device for communication and, in another way, for the programming of the operator to communicate upon actuation with a particular device.

When appellants argued that the claims require enabling different actuations of said operators to be interpreted selectively, the examiner responded by asserting that the claims do not require actuation in "different" ways to produce "different" results.

We disagree. While the claims may not explicitly recite different "ways" and different "results," that is clearly what is being described. In claim 1, for example, there is an enabling of "different actuations" of operators. Clearly, this refers to different ways to actuate so that the actuations can be distinguished from each other. The claim also requires that these different actuations are to be "interpreted selectively." That means that each different type or way of actuation will result in some different action, because each is interpreted in a selective manner. In particular, the selective interpretation will entail either the selection of a device for

communication OR the programming of the operator. Thus, it is clear to us that claims 1 and 11 do, indeed, require actuation in different ways to produce different results.

Nothing of the sort is taught or suggested by either one of Erekson or Goldstein.

However, even if we interpreted the disclosure of these references to teach the elements of the claims as alleged by the examiner, which we do not, we find the examiner's rationale for combining the references to sound suspiciously like hindsight. The examiner's specific rationale, viz., "in order to for the said remote device to be functionally capable to select a plurality of devices to communicate within an environment to further program the said icon to communicate the said selected device" [sic] [Paper No. 4, page 3] is a very general statement with nothing concrete to explain why the skilled artisan, viewing these references, would have sought to combine them.

Appellants appear to make a reasonable assessment (reply brief-page 4) when arguing that Erekson does not display an icon unless a device responds to a broadcast, so it appears that an artisan would find no reason to modify this teaching by Goldstein which, the examiner alleges, employs icons which are actuated in order to connect to the devices. The examiner has no convincing retort to appellants' argument.

Accordingly, we will not sustain the rejection of claims 1-9 and 11-20 under 35 U.S.C. §103 as unpatentable over Erekson and Goldstein. Darbee, applied in addition to Erekson and Goldstein with regard to claims 8 and 18, does not provide for the deficiencies of the primary references.

Turning to the rejection of independent claim 21 under 35 U.S.C. §103 over Erekson and Kolde, the examiner cites transceiver 108, at column 6, lines 17-20 and 50-54, as the claimed "wireless device," the address/data bus 110, at column 5, lines 38-45, as the claimed "controller, coupled to the transceiver (citing column 6, lines 47-50), column 2, lines 9-16, for sending a broadcast message to identify and locate a variety of compliant devices in the area of remote communication, as the claimed "enumerating a plurality of devices for wireless communication, and column 2, lines 27-30, for remotely selecting one of the devices for communication.

The examiner notes that Erekson does not disclose "a mouse apparatus where the wireless interface is clearly coupled to the said apparatus" (final rejection, Paper No. 4, August 26, 2004 - page 10). The examiner then turns to Kolde, paragraph [0030], where wireless interface remote control 106 is provided as either a wired or wireless mouse.

The examiner then concludes that it would have been obvious to modify the teachings of Erekson with Kolde "in order to provide the user with the functional aesthetic appeal of a hand-held computing device incorporated with a mouse capability for easy navigation and control of the said selected devices" (final rejection, Paper No. 4, August 26, 2004 - page 10).

Our review of the record leads us to the conclusion that the subject matter of independent claim 21 would have been obvious, within the meaning of 35 U.S.C. §103, over the combination of Erekson and Kolde.

The subject matter of claim 21 is directed, broadly, to a "system" having three components: a mouse, a wireless interface coupled to the mouse, and a controller coupled to the

wireless interface to enumerate a plurality of devices and remotely select one of the devices for communication.

Clearly, Erekson discloses the control of a remote device over a wireless interface (see the first line of the Abstract) where a plurality of remote devices are enumerated on and one of the remote devices is selected by a hand held device (Abstract, column 5, lines 38-45, column 6, lines 5-19). In fact, the only difference between what is disclosed by Erekson and recited in broad claim 21 is that whereas Erekson uses a hand held device having a screen and icons for the apparatus which communicates with and chooses a remote device, claim 21 employs a "mouse apparatus.

However, in view of Kolde's disclosure that a mouse, either wired or wireless, may be used for communicating with remote devices (Paragraph [0030] discloses that one type of remote control which may be used is a "wireless mouse"), it is clear to us that the artisan would have been led to the use of such a wireless mouse as one type of equally obvious remote control device for use in Erekson in selecting and controlling one of several remote devices.

Appellants argue that such a combination would require a substantial redesign in Erekson, disposing of the hand held screen with the icons in place of a mouse. We disagree. 35 U.S.C. §103 does not require the outright substitution of one element for another, i.e., bodily incorporation, when combining references, but rather that the combination of references would have fairly suggested to one skilled in the art the claimed subject matter. Clearly, Erekson

suggests the selection and control of one of a plurality of remote devices by an apparatus. Kolde suggests that one known type of a remote controller is a wireless mouse. Clearly then, the skilled artisan would have realized that such a wireless mouse may be used as the apparatus for selecting and controlling one of a plurality of remote devices. Merely because Erekson teaches a very specific way of selecting and controlling remote devices, viz., through the selection of icons on a hand held device (palmtop or hand held computer), this does not negate the use of other known ways and apparatus for selecting and controlling the remote devices. In view of Kolde's teaching, it would have been obvious, within the meaning of 35 U.S.C. §103, to employ a wireless mouse as the apparatus for selecting and controlling one of a plurality of remote devices.

Accordingly, we will sustain the rejection of claim 21 under 35 U.S.C. §103.

Appellants separately argue the merits of dependent claims 26, 27, and 30.

With regard to claim 26, appellants argue that the plurality of programmable operators, each of the operators being programmable to select one of a plurality of sufficiently proximate devices, is not disclosed by Erekson. In particular, appellants admit that Erekson may include programmable buttons 75, but there is no indication that these buttons are programmed with the identity of one of a plurality of devices and it has not been shown that the icons on display 105 are user programmable with the identity of one of the plurality of devices.

We disagree with appellants. As disclosed in column 8, lines 33-55, of Erekson, remote devices are located and identified by transmitting a broadcast message. When a compliant

remote device is in the vicinity, an icon appears, or is assigned, on the hand held device and that icon is then used by the user to select a particular remote device. Thus, the icon is an operator that is programmed to select one of a plurality of sufficiently proximate devices, as claimed. Again, it is the icons, not button 75, which the examiner identifies as the claimed programmable operator.

Having thus found that the icons, once presented on the display, are the programmable operators, the artisans would have found it obvious that such icons may be replaced by buttons to be pressed rather than icons to be touched. Accordingly, we will sustain the rejection of claims 26 and 27 under 35 U.S.C. §103.

Claim 30, dependent on claims 21 and 29, calls for storing identifying information about the sufficiently proximate device in a volatile storage initially, and then selectively transferring the information to a nonvolatile storage.

Appellants argue that the examiner has not shown this operation in Erekson. While appellants admit that Erekson depicts a volatile and non-volatile memory, there is no indication that the remote device characteristics are initially stored in volatile memory.

We agree with appellants that while Erekson discloses a volatile and non-volatile memory, e.g., column 5, lines 43-53, there is absolutely no indication in Erekson as to initially storing identifying information about the sufficiently proximate devices in a volatile storage and then selectively transfer that information to the non-volatile storage. If there is any obvious reason for doing so, the examiner has not postulated such a reason.

Accordingly, we will not sustain the rejection of claim 30 under 35 U.S.C. §103.

CONCLUSION

We have sustained the rejection of claims 21 and 24-29 under 35 U.S.C. §103 but we have not sustained the rejection of claims 1-9, 11-20, and 30 under 35 U.S.C. §103.

Accordingly, the decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

KENNETH W. HAIRSTON Administrative Patent Judge	)
ERROL A. KRASS Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
HOWARD B. BLANKENSHIP Administrative Patent Judge	)

EAK/dpv

Trop, Pruner & Hu, PC
8554 Katy Freeway
Suite 100
Houston, Texas 77024